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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/049,616 | 02/21/2002 | Toru Kamimura | 020179 | 4516 |

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EXAMINER

GRIER, LAURA A

ART UNIT PAPER NUMBER

2644

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/049,616 | Applicant(s) KAMIMURA ET AL. | |
| | Examiner Laura A. Grier | Art Unit 2644 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 9-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The indicated allowability of claim 9 is withdrawn in view of the newly discovered reference(s) to Heo and the 112 2nd paragraph rejection. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 9, respectively, each recite, "... a second format". The claim language fails to limit or indicate what is being referred to in "a second format". Is the claim language referring to a second encoded sound signal or the sound signal being in a second encoded format or second decoding format for the decoding operation? The claim language of claims 1 and 10 also recite, "a determining means for determining whether or not a format agrees between said sound signal and said second decoding program". It is unclear the examiner as to which format is being determined and/or compared the agree with the sound signal and the 2nd decoding program, and then making a validating decision based upon the prior determining means. Is it referring to the 1st format, the 2nd format or any other possible format. Accordingly, the claim language is indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 5, 9 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Heo, U. S. Patent No. 6449227.

Regarding **claim 1**, Heo discloses a DVD-Audio Disk and apparatus and method for playing the same. Heo's disclosure comprises a DVD-Audio (a disk) which stores audio data to be reproduced, wherein the audio data may be among a plurality of audio codes, and the DVD-Audio also includes decoding algorithms (col. 2, lines 27-43, col. 13, lines 62-64), which indicates a recording means. Heo discloses a DVD-Audio player which includes an audio decoder (115) which functions in respect the system controller and is able to decode various audio data codes (formats), the decoder includes buffers, which indicates a storage means for storing a second decoding program; wherein is inherent that the system controller (111) constitutes as a determining and a validating means for determining which decoding method is applicable (figure 27 and 28, col. 23, lines 44-67 – col. 24, lines 1-64); and audio output circuit (117) and digital audio output, which reads on an outputting means.

therein; a DVD-Audio player comprising controller (111) coupled to a pickup device (112), a data receiver (112), which reads on a loading means; and a decoder (115) is also coupled thereto - (), which indicates a decoding means; Heo

Regarding **claim 5**, Heo discloses a DVD-Audio Disk and apparatus and method for playing the same. Heo's disclosure comprises a DVD-Audio (a disk) which stores audio data to be reproduced, wherein the audio data may be among a plurality of audio codes, and the DVD-Audio also includes decoding algorithms (col. 2, lines 27-43, col. 13, lines 62-64), which indicates a recording means, therein; a DVD-Audio player comprising controller (111) coupled to a pickup device (112), a data receiver (112), which reads on a loading means; and a decoder (115) is also coupled thereto - (figure 27, col. 23, lines 44-67 – col. 24, lines 1-11), which indicates a decoding means; and audio output circuit (117) and digital audio output, which reads on an outputting means.

Regarding **claim 9**, Heo discloses a DVD-Audio Disk and apparatus and method for playing the same. Heo's disclosure comprises a DVD-Audio (a disk) which stores audio data to be reproduced, wherein the audio data may be among a plurality of audio codes, and the DVD-Audio also includes decoding algorithms (col. 2, lines 27-43, col. 13, lines 62-64), which indicates a recording means. Further, the DVD-Audio player comprises the system controller (111) coupled to a pickup device (112), indicating an attacher; a data receiver (112), the function of all indicates a loader; and a decoder (115) is also coupled thereto. Heo discloses a DVD-Audio player which includes an audio decoder (115) which functions in respect the system controller and is able to decode various audio data codes (formats), the decoder includes buffers, which indicates a storage means for storing a second decoding program; wherein is inherent that the system controller (111) constitutes as a determiner and validator for determining which

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decoding method is applicable (figure 27 and 28, col. 23, lines 44-67 – col. 24, lines 1-64); and audio output circuit (117) and digital audio output, which reads on an outputter. Heo further indicates that decoding based upon the number bit for the particularly coded audio data of PCM or compression coded audio data (col. 24, lines 12-50, and col. 30, lines 37-51), thus indicates a the recording means recording the decoding programs according the a 1st number-of-bit operation a 2nd number-of-bit operation.

Regarding **claim 10**, Heo discloses a DVD-Audio Disk and apparatus and method for playing the same. Heo's disclosure comprises a DVD-Audio (a disk) which stores audio data to be reproduced, wherein the audio data may be among a plurality of audio codes, and the DVD-Audio also includes decoding algorithms (col. 2, lines 27-43, col. 13, lines 62-64), which indicates a recording medium, wherein the DVD-Audio is input to a DVD-Audio player comprising a pickup device (112), which reads on an attaching means, therein; further the controller, pickup device and a data receiver (112) are couple together, thus constituting on a loading means; and a decoder (115) is also coupled thereto - (figure 27, col. 23, lines 44-67 – col. 24, lines 1-11), which indicates a decoding means; an audio output circuit (117) and digital audio output, which reads on an outputting means; Heo further indicates that decoding based upon the number bit for the a particularly coded audio data of PCM or compression coded audio data (col. 24, lines 12-50, and col. 30, lines 37-51), which indicates a decoding program including a 1st decoding program for a 1st number-of-bit operation and a second decoding program for a 2nd number-of-bit operation, wherein the decoding program information is transfer the decoder for the DVD-Audio via the transfer of audio data information, to indicates loading a 1st decoding program from the recording medium.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 5, 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

The applicant provided an English Translation of the priority document to overcome the prior art rejections of Lueck and Fujii, respectively. A new prior art rejection has been provided in date guidelines that support the claimed limitations in respect the a recording medium including a sound signal encoded in a 1st format and a corresponding decoding program on the medium as well, wherein the recording medium can be used in a compatible device and analyzed as claimed.

Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Galensky et al., U. S. Patent No. 6845398, discloses an wireless multimedia player.

Janky et al., U. S. Patent No. 6549942, discloses enhanced delivery of audio data for portable playback.

Scibora, U. S. Patent No. 6366544, discloses a universal CD player.

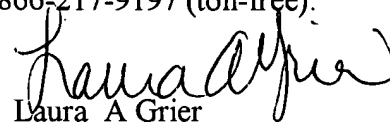
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A. Grier whose telephone number is (571) 272-7518. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura A Grier
Primary Examiner
Art Unit 2644
October 25, 2005